

### **REMARKS**

By this Amendment, Applicant amends claims 1-11 for clarity and to more appropriately define Applicant's invention, and cancels claim 12 without prejudice or disclaimer of the subject matter thereof. No new matter is added. Claims 1-11 are now pending in this application.

In the Office Action mailed March 2, 2004, the Examiner noted that claims 1, 4, and 5 lacked sufficient antecedent basis for the limitations "said interface," "said wireless communication," "said non-activation time," and "which memory." By this Amendment, Applicant has amended claims 1, 4, and 5 to provide proper antecedent basis for these terms. Accordingly, Applicant respectfully requests the Examiner to note that corrections have been made.

The Examiner rejected claim 1 under 35 U.S.C. § 102(e) as anticipated by Fiske (U.S. Patent No. 6,324,692); rejected claims 2 and 12 under 35 U.S.C. § 103(a) as unpatentable over Fiske in view of Sakurai et al. (U.S. Patent No. 5,363,229); rejected claim 3 under 35 U.S.C. § 103(a) as unpatentable over Fiske in view of Sakurai, and in further view of MacConnell (U.S. Patent No. 5,398,280); rejected claims 4-7 and 9-11 under 35 U.S.C. § 103(a) as unpatentable over Cromer et al. (U.S. Patent No. 6,334,147, "Cromer-1") in view of Cromer et al. (U.S. Patent No. 6,334,150, "Cromer-2"); and rejected claim 8 under 35 U.S.C. § 103(a) as unpatentable over Cromer-1 in view of Cromer-2, and in further view of Maruyama et al. (U.S. Patent No. 5,463,663).

Applicant respectfully traverses the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by Fiske. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art

reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8<sup>th</sup> ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001), p. 2100-69.

Applicant’s claim 1 recites a computer system managed by a terminal having a wireless communication function comprising, among other things, “a system management controller connected to said wireless communication interface and the second bus, which performs system management instructed by said terminal, through wireless communication with said terminal via said wireless communication interface, wherein the CPU accesses the non-volatile memory via the first bus when the computer system is in an active state and the system management controller accesses the non-volatile memory via the second bus when the computer system is in a non-active state.” Fiske does not disclose at least these features.

By contrast, Fiske discloses a method and processor program for performing an upgrade of a program. An upgraded version of the program is received into the processor and a backup of the program is created in memory associated with the processor. The upgraded version of the program is installed and the processor is rebooted. See col. 1, lines 54-59. However, Fiske does not disclose at least “a system management controller connected to said wireless communication interface and the second bus, which performs system management instructed by said terminal, through wireless communication with said terminal via said wireless communication interface, wherein the CPU accesses the non-volatile memory via the first bus when the computer

system is in an active state and the system management controller accesses the non-volatile memory via the second bus when the computer system is in a non-active state.” Fiske therefore does not disclose each and every feature of claim 1. Accordingly, the Examiner should withdraw the rejection of claim 1.

Applicant respectfully traverses the rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Fiske in view of Sakurai. Because Applicant has canceled claim 12 without prejudice or disclaimer, the rejection of claim 12 is moot.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant’s disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 2 depends from allowable claim 1. As discussed above, Fiske does not disclose each and every feature of claim 1. Additionally, the Examiner admits Fiske does not teach several features of claim 2 (Office Action, page 2). However, Sakurai, which discloses an optical bus transmission system, does not make up for the deficiencies of Fiske, as discussed above.

In addition, the Examiner alleges it “would have been obvious to one of ordinary skill in the art at the time the invention was made given [Fiske’s] suggestion where a managed computer communicates with a managing terminal indicating the said computer ... to include Sakurai’s teachings for including [a] command, [and] identifying ... status information in the wireless transmission packet” (Office Action, page 2). The Examiner alleges such “[m]otivation would be to enable wireless communication with specific computers among a plurality of [computers] for performing managing operations remotely” (Office Action, page 3). However, the Examiner has not shown that such a motivation is found in the prior art, nor that such a combination would prove effective. Accordingly, for at least the above reasons, the Examiner should allow claim 2.

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over Fiske in view of Sakurai, and in further view of MacConnell. Claim 3 depends from allowable claim 1. As discussed above, Fiske and Sakurai, taken alone or in combination, do not disclose or suggest all of the features of claim 1. The Examiner admits neither Fiske nor Sakurai teach displaying a connection status. Further, MacConnell, which discloses a paging system for remote computers, does not make up for the deficiencies of Fiske and Sakurai, as discussed above.

The Examiner also alleges that there is motivation to combine the teachings of Fiske, Sakurai, and MacConnell (Office Action, page 3). Applicant respectfully points out to the Examiner it “is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” See In re Wesslau, 147 U.S.P.Q. 391

(C.C.P.A. 1965). See *also* M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references must “be found in the prior art, and not based on applicant’s disclosure.” See M.P.E.P. § 2143 (emphasis added). For at least the above reasons, the Examiner should allow claim 3.

Applicant respectfully traverses the rejection of claims 4-7 and 9-11 under 35 U.S.C. § 103(a) as unpatentable over Cromer-1 in view of Cromer-2.

Applicant’s claim 4 recites a computer system managed by a terminal having a wireless communication function comprising, among other things, “a system management bus operable even at a non-activation time of said computer system, which is directly or indirectly connected to various information storing means of said computer system, wherein the CPU accesses the information storing means via the first bus when the computer system is in an active state and said system management controller includes an information access means for recovering, modifying, or reading out information on said information storing means, via said system management bus, depending on said request when receiving a request for recovering, modifying, or reading out said information on said information storing means of said computer system from said terminal when the computer system is in a non-active state.” Cromer-1 and Cromer-2, taken alone or combination, do not disclose or suggest at least these features.

By contrast, Cromer-1 discloses a data processing system and method for remotely accessing a client computer system’s individual initialization settings. Client 104 may response to a wakeup signal from network adapter 230, and in response, power supply 240 is turned on and then powers up client 104. See col. 5, lines 7-10.

ASIC 300 may access data from client computer system 104 over a system management bus 238, however, ASIC 300 is preferably powered full time. See col. 5, lines 60-66. Additionally, Cromer-2, which includes similar disclosures to that of Cromer-1, discloses rendering a client computer system inoperable by using a wireless signal. Cromer-2, however, does not make up for the deficiencies of Cromer-1.

Nor is there a motivation to enable the managed computer system with wireless communication interface means to receive wireless communication from the remote managing computer terminal, as alleged by the Examiner (Office Action, page 4). Motivation must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Accordingly, for at least these reasons, the Examiner should withdraw the rejection and allow claim 4.

Applicant's claim 10, while of a different scope, includes recitations of a similar scope as claim 4. For example, claim 10 recites a computer management system comprising, among other things, "a system management controller connected to said wireless communication interface, for performing system management instructed by said terminal, through said wireless communication with said terminal via said wireless communication interface, wherein the CPU accesses the non-volatile memory via the first bus when the computer system is in an active state and the system management controller accesses the non-volatile memory via the second bus when the computer system is in a non-active state." For at least the same reasons as discussed above, the Examiner should allow claim 10.

Claims 5-7 and 11 depend from allowable claims 4 and 10, respectively. For at least the same reasons discussed above in relation to allowable claims 4 and 10, the Examiner should also allow claims 5-7 and 11.

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over Cromer-1 in view of Cromer-2, and in further view of Maruyama.

Claim 8 depends from allowable claim 4. As discussed above, Cromer-1 and Cromer-2 do not disclose or suggest claim 4. Further, Maruyama does not make up for the deficiencies of these references. Maruyama discloses an apparatus for control synchronization in system. However, Maruyama, taken alone or in combination with Cromer-1 and Cromer-2, do not disclose or suggest all of the features of claim 8. Nor is there a motivation to combine the teachings of Maruyama to restart operation between computer components that are accessible by a system bus without interrupting the operation of other components, as alleged by the Examiner (Office Action, page 6). As noted, motivation must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). For at least these reasons, the Examiner should allow claim 8.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 28, 2004

By: Anthony L. Lili Reg. No. 53,232  
for Richard V. Burgujian  
Reg. No. 31,744